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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Corts

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Davenport Law Offices  
5018 Holly Ridge Drive  
Raleigh, NC 27612

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/839,451	<b>Applicant(s)</b> CORTS ET AL.	
	<b>Examiner</b> Donald L. Champagne	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 229-246 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 229-246 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 August 2009 has been entered.

### ***Claim Numbering***

2. The numbering of claims is not in accordance with 37 CFR 1.75 which requires claims to be numbered consecutively (i.e., there is no claim 235). Misnumbered claims 236-247 have been renumbered 235-246.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 229-237 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Beginning at line 2 of claim 229, "a second information provider" is new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 229-237 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards

Art Unit: 3688

as the invention. At numerous places beginning with line 6 of claim 229, **broadcast content** is indefinite. See para. 10 below.

7. Claims 229-239 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At numerous places beginning with line 4 of claim 229, **supplemental information** is indefinite. See para. 12 below.
8. Claim 244 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "Unrelated" is indefinite. The application (para. [0150] of the published application, US 20020141491A1, hereafter "the PGPub") gives an example, but an example does not constitute an "explicit" and "clear" definition beyond the scope of the example (para. 9 below).

#### ***Interpretation of claim Language***

9. Note on interpretation of claim terms - Unless a term is given an "explicit" and "clear" definition in the specification (MPEP § 2106.II.C), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skilled in the art (MPEP § 2111). This means that the words of a claim must be given their "plain meaning" unless the plain meaning is inconsistent with the specification (MPEP § 2111.01.I and 2111.01.III). An explicit and clear definition must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes ... but does not include ...". An example does not constitute an "explicit" and "clear" definition beyond the scope of the example. An applicant may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning (MPEP § 2111.01.IV and 2173.05(a)).
10. **First broadcaster party** (e.g., claim 229, line 2) is not disclosed in the spec. **Broadcaster** is widely disclosed but not defined. The spec does disclose **broadcast data** to be "analog

audio" (para. [0039] of the PGPub) and the spec. defines a "broadcast facility", including "a radio station",<sup>1</sup> as a facility which combines "supplemental digital data ... with the audio data (e.g. broadcast data) to form a data-cast" (PGPub para. [0035]). Hence, **first broadcaster party** and **broadcaster** are both interpreted as facilities that transmit analog audio **broadcast data** and may also be the distributor of the combined data-cast.

11. **Broadcast content** (e.g., claim 229, line 6) is disclosed only once in the spec. ([0191] of the PGPub) and is undefined. **Broadcast content** is interpreted to be **broadcast data**.
12. **Information provider** (e.g., claim 241, line 2) and **second information provider** (e.g., claim 229, line 2) are not disclosed in the spec. Both terms are interpreted to mean any provider of supplemental digital data (para. [0012] of the PGPub).
13. **Supplemental information** (e.g., claim 229, line 3) is not disclosed in the spec. From the claim context (claim 229 lines 6-7 and claims 231, 233-235 and 238), **Supplemental information** is interpreted to be "supplemental digital data" (para. [0012] of the PGPub).

#### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 229, 230, 232-236, 238 and 239 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US006192340B1).
16. Abecassis teaches (independent claims 229 and 238) a method and system, the method (claim 229) comprising:

Sending, to a second information provider (*dedicated information provider*, col. 17 lines 37-42) a broadcast schedule information (inherently, from col. 24 lines 51-58 and col. 20 lines 23-35) comprising data relating to a future broadcast by a first broadcaster party (*provider 411*, col. 11 lines 1-3 and 6-8).

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<sup>1</sup> This limitation is also claim 242.

Art Unit: 3688

receiving from the second information provider supplemental information associated with the data relating to the future broadcast (col. 2 lines 63-65 or col. 3 lines 49-51); and

the first broadcaster party concurrently (*in a substantially real time basis*, col. 24 lines 51-58) sending through an electromagnetic medium broadcast content according to the broadcast schedule information and the supplemental information to an end user device for playback of the broadcast content to the end user in conjunction with access to the supplemental information by the end user (also col. 3 lines 51-54, where *audio library* is defined at col. 2 lines 36-37, 41-45 and 51-53).

17. Abecassis does not explicitly teach sending broadcast schedule information. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Abecassis teaches information is preferably obtained and played in a substantially real time basis (col. 24 lines 51-58). This could be accomplished only if the schedule was sent in advance to a second information provider/*dedicated information provider*.
18. Abecassis does not teach that said sending is by said broadcaster party/provider 411. However, under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would be obvious to have said sending done by the broadcaster party/*provider 411* because it requires choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. The sending to the second information provider/*dedicated information provider* can only be done (1) directly by an *end user 431* (col. 11 lines 1-6) or (2) the broadcaster party/*provider 411*. There are no other possibilities.
19. Abecassis also teaches at the citations given above claims 230, 232, 233 and 239.
20. Abecassis also teaches: claim 234 (col. 2 lines 11-19); claim 235 (col. 29 lines 22-26); and claim 236 (col. 19 lines 1-16 and Fig. 6).
21. Claims 231, 237 and 240-246 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US006192340B1) in view of Kumar (US005949796A).
22. Abecassis does not teach (independent claims 240 and 246, and dependent claims 231 and 237) sending the supplemental information in a sideband and transmission in an in-band, on-channel (IBOC) format. Kumar teaches sending the supplemental information in a

Art Unit: 3688

sideband and transmission in an IBOC format (abstract). Under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination of Abecassis and Kumar would be obvious because prior art elements are being combined according to known methods to yield predictable results. Abecassis (col. 1 lines 8-12) has the objective of integrating supplemental digital information with radio audio broadcast and teaches every feature of the claims except supplemental information in a sideband and IBOC transmission. Kumar teaches these technical features (abstract) and teaches (col. 1 lines 46-49) that they help achieve Abecassis's objective.

23. Abecassis also teaches at the citations given above claims 241, 243 and 244 (at the end of the Abstract. Abecassis also teaches claim 242 (col. 11 lines 17-19) and claim 245 (col. 1 lines 44-51 and col. 24 lines 51-58).

### ***Response to Arguments***

24. The applicant's arguments have been considered in the rejection.

### ***Search for Allowable Matter***

25. The examiner has searched this application for potentially allowable matter (i.e., a feature of the disclosed invention that would overcome the rejection of record) and regrets to report that none was found. If applicant believes any one or more features are potentially patentable, it would behoove the applicant to clearly identify those features in writing. This application is qualified for interview by the usual procedures.

### ***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
27. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782. The fax phone number for all *formal* fax communications is 571-273-8300.

Art Unit: 3688

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22 May 2010

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688